



UNITED STATES PATENT AND TRADEMARK OFFICE

59
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,443	10/11/2001	Rabindranath Dutta	AUS920010169US1	9168

7590 04/12/2005

Marilyn Smith Dawkins
International Business Machines Corporation
Intellectual Property Law Dept., Internal Zip 4054
11400 Burnet Road,
Austin, TX 78758

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/975,443

Examiner

Doug Hutton

Applicant(s)

DUTTA ET AL.

Art Unit

2179

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 04 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


HEATHER R. HERNDON

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 11. does NOT place the application in condition for allowance because:

The amendments to the claims do not modify the scope of the present invention, and the examiner does not find Applicant's arguments persuasive.

In support of Claims 1-3 and 5-9, Applicant argues that Amro fails to disclose "in response to receiving a designated user action, displaying the list of identified document components" because the mini window displays an outline only for the page of the document currently represented by the position of the elevator. In contrast, Applicant argues, the present invention displays the list of identified document components and not just the components of the current page represented by the position of the elevator.

The examiner disagrees, because Amro discloses that the user can move the elevator and the mini window up and down on the scroll bar and, while doing so, the mini window displays an outline of the compound document's page corresponding to the position of the elevator. Thus, the mini window will display an outline for the entire document as the user moves the elevator and mini window up and down on the scroll bar.

In support of Claims 1-3 and 5-9, Applicant argues that Amro fails to disclose "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document components" because the system does not receive a "user selection of any content within the mini window." Applicant supports the argument by emphasizing that the present invention requires a "selection" of "one of the identified document components within the list." The examiner disagrees. The relevant claim language requires a "user selection of one of the identified components within the list," and Amro discloses this limitation in that: 1) by clicking the second mouse button and moving the elevator and the mini window up and down on the scroll bar, a user scans the entire document and all components within the document; and 2) upon locating the desired content through moving the elevator and the mini window up and down on the scroll bar, a user releases the second mouse button and thus "selects" one of the "identified document components." That is, the release of the second mouse button upon locating the desired content comprises a "selection." Thus, the system disclosed in Amro comprises a "selection" of "one of the identified document components within the list."

The relevant claim language also requires: "displaying another portion of the document containing the selected identified document components." Amro discloses this limitation in that, upon the user releasing the second mouse button, the "selected document component" is displayed when the lengthy document is automatically scrolled to that portion of the document that includes the "selected component."

Applicant's arguments that Amro "teaches away" are not persuasive. In fact, those portions of Amro cited for "teaching away" actually disclose the limitations of the claims, as currently recited.

In support of Claims 2, 7 and 9, Applicant arguments mirror the above arguments. The examiner disagrees, as indicated in the above discussion.

In support of Claim 4, Applicant admits that Kuppusamy discloses storing the contents of the TOC document "using conventional document saving techniques" and then argues that Kuppusamy fails to disclose "storing the list in a cache," as recited in the claim. The examiner disagrees. A "cache" is a special, high-speed storage mechanism that can be a reserved section of main memory. A cache is used to store data and/or instructions that are to be accessed over and over, such as the TOC document disclosed in Kuppusamy. Because Kuppusamy discloses many different types of memory for the computing environment and a set of data that is to be accessed over and over (the TOC document), it also discloses that the TOC document is "stored in a cache." Moreover, storing data - such as a list of data items - in a cache was well-known by one of ordinary skill in the art (i.e., a computer programmer) at the time the present invention was made, as demonstrated by Amro (see the rejection for Claim 1).

In support of Claim 4, Applicant's arguments regarding Amro mirror the above arguments in support of Claims 1-3 and 5-9. The examiner disagrees, as indicated in the above discussion.

In support of Claim 4, Applicant argues that the combination of Kuppusamy and Amro is improper because it would render both unsuitable for their intended purpose.

The examiner disagrees. Amro is used for the sole purpose of teaching that the "list of identified document components," disclosed in Kuppusamy, can be automatically created rather than requiring the user to indicate that he desires that the "list" be created. Proper motivation to combine this feature of Amro with Kuppusamy is recited in the claim. Thus, the combination of Kuppusamy and Amro is proper and does not render the system disclosed in Kuppusamy unsuitable for its intended purpose.

In further support of Claim 4, Applicant argues that the combination of Kuppusamy, Amro and Sotomayor is improper because it would render both Kuppusamy and Amro unsuitable for their intended purpose.

The examiner disagrees. Sotomayor is used for the sole purpose of teaching that the list of identified document components, disclosed in Kuppusamy (examiner notes that Amro is not used to teach a "list" in the rejection for Claim 4), can be displayed "in alphabetical order." Proper motivation to combine this feature of Sotomayor with Kuppusamy is recited in the claim. Thus, the combination of Kuppusamy, Amro and Sotomayor is proper and does not render the system disclosed in Kuppusamy unsuitable for its intended purpose.

In support of Claim 5, Applicant's arguments regarding Amro mirror the above arguments in support of Claims 1-3 and 5-9. The examiner disagrees, as indicated in the above discussion.